

35. (Amended Twice) The film of claim 33 wherein the borate accelerants have the formula  $(R''O)_3B$  where  $R''$  is independently chosen from straight, cyclic or branched-chain alkyl or alkenyl of from one to about six carbons' phenyl, substituted phenyl, or  $R'''CH_2CH_2$ , where  $R'''$  is  $MeO_2C-$ ,  $EtO_2C-$ ,  $CH_3CO-$ , or  $HOOC-$ .

### REMARKS

The amendments to claims 34 and 35 delete the term "organic" before "phosphite" and "borate" respectively since the formulas for these compounds inherently include the term in the radical "R." The amendment therefore does not go to issues of patentability.

In the April 13, 2001 Office Action, the Examiner acknowledged Applicants' January 26, 2001 response, noting that at the subsequent interview held on March 8, 2001, the response did not discuss all of the Applicants' PCT applications, which applicants will refer to as the "non-priority PCT applications." The Examiner gave applicants' attorneys the serial numbers and filing dates of these non-priority PCT applications, and they said they would address them.

Applicants also discussed the priority great grandparent and parent applications at the interview and therefore will address not only the non-priority PCT applications, but also whether prosecution of the composition claims in the parent application bars the composition claims of the present reissue application and secondly, whether the prosecution of article of manufacture claims in the great grandparent application bars the film and article claims of this reissue application. The priority grandparent application, however, although containing article claims, also contained method claims

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that applicant elected to prosecute after the Examiner imposed a restriction requirement. Applicants will also address this application because of its priority status.

The Examiner rejected the priority great grandparent and grandparent applications but applicants never responded to the rejections. Accordingly, the Examiner never issued a final rejection in either, and applicants neither amended them, canceled any claims from them, or submitted any arguments in them as to patentability, and never acquiesced to the rejections in any way, but rather filed a continuation-in-part PCT application based on both. That priority PCT application in turn became the basis for the parent application, and should not be confused with the non-priority PCT applications.

As to the non-priority PCT applications, applicants initially point out that 37 C.F.R. § 1.11 makes the present reissue application, available for public inspection, which includes this response. Because 37 C.F.R. §1.14 (Rule 14) provides for maintaining these non-priority PCT applications in confidence, applicants decline to specifically discuss them, or identify them by serial number and filing date, since Rule 14 also makes them available to the public if identified in a publicly available document. Applicants, however, will address the non-priority PCT applications generally to address the issues raised.

Case law makes clear that the recapture doctrine applies only to amendments or arguments that address patentability issues advanced during the course of prosecution of an application in order to overcome a rejection. Where an Applicant has not urged patentability in either way, recapture does not exist. Ball Corp. v. United States, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984); In re Wallingham, 282 F.2d, 353, 127

U.S.P.Q. 211-215 (C.C.P.A. 1960); In re Wadlinger et al., 496 F.2d 1200, 181 U.S.P.Q. 826, 830, 832 (C.C.P.A. 1974). Also, "where claims have not been previously cancelled, relative claim scope is not available to illuminate the alleged error" Ball, 729 F.2d at 1434, 221 U.S.P.Q. at 295, and fn. 19 (Emphasis added).

As to applicants' filing the continuation-in-part rather than addressing the non-final rejections in the great grandparent and grandparent applications, the Court of Appeals for the Federal Circuit pointed out:

[t]he filing of a continuation-in-part, in and of itself is not an admission of the correctness of a rejection. Law and policy liberally authorize the filing of c-i-p applications for a number of reasons, whether to enlarge the disclosure to include new technological information, thereby providing the public with knowledge of recent developments or improvements; or to enable more extensive prosecution or improved draftsmanship of specification or claims; or to provide a vehicle for prosecution of non-elected claims.

Paperless Accounting v. Bay Area Rapid Transit System, 804 F.2d 659, 231 U.S.P.Q. 649, 652 (Fed. Cir. 1986). Also, where an Examiner has not made a final rejection, applicants' subsequent filing of a CIP application does not amount to acquiescence to any outstanding rejections in the parent application. Paperless Accounting, 804 F.2d at 231 U.S.P.Q. at 652.

The prosecution history shows that the present application derives from the great grandparent, grandparent, PCT continuation-in-part, and parent applications. This chain of applications comprises the priority applications upon which applicants rely for their earliest filing date. Applicants have not incorporated the non-priority PCT applications in the chain that makes up the priority applications of the present case.

Members of the public and especially competitors of the applicants

could not look to the non-priority PCT applications as bearing on the prosecution of the present reissue application, and therefore could not rely on any statements made by the applicants in those applications to determine the scope of protection applicants sought in the parent application. Applicants' did not give up any subject matter of any of the non-priority PCT applications in order to obtain allowance of claims in the parent application. Again, these non-priority PCT applications are not accessible to the public under Rule 14 and the Patent and Trademark Office should not require applicants to divulge their identity thereby making them accessible to the public under Rule 14. The Patent and Trademark Office preserves those applications in confidence, and Applicants respectfully request the Office to continue to preserve them in confidence.

The Examiner has allowed the reissue composition of matter claims 1-27. As to other reissue composition claims 28-29 and 31-32, applicants point out that, similar to allowed claims 1-27, they also include a silicon oxide precursor, and a limitation that deposition occurs at a rate greater than 350Å/sec., making them more narrow than composition claims 1-19 of the great grandparent application which does not include this limitation.<sup>1</sup>

Importantly, the Examiner never rejected composition claims 1-19 of the great grandparent application since applicants elected (with traverse) to prosecute article of manufacture claims 20-50 in that application in response to a restriction requirement.

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<sup>1</sup> Applicants' attorneys do not in any way intend to limit the claims of any of the great grandparent, grandparent, PCT, parent or reissue applications by the summaries of claims of those applications as set forth throughout this response.

The Examiner therefore cannot look to the great grandparent application to apply the recapture doctrine to reissue claims 28-29 and 31-32.

Reissue film and article claims 33-60 do not recapture subject matter given up in the great grandparent application in order to advance prosecution or obtain an allowance. Although the Examiner made a prior art rejection of article claims 20-50 in the great grandparent application, applicants never cancelled the claims nor did they amend them, or present arguments of any kind in order to overcome the rejection. Subsequent to filing the great grandparent application (and for that matter, the grandparent application) applicants filed the PCT application and the parent application, which claims the priority of all three.

The Examiner never finally rejected article of manufacture claims 20-50 in the great grandparent application and accordingly, applicants never acquiesced to that rejection by filing a continuation-in-part application since "the filing of a continuation-in-part, in and of itself is not an admission of the correctness of a rejection," especially where the rejection is not a final rejection. Paperless Accounting, 231 U.S.P.Q. at 652. The prosecution history of the great grandparent application therefore does not raise any recapture issues regarding reissue claims 33-60.

As to the grandparent application, Applicants point out that they elected to prosecute method claims 1-27 (again, with traverse) which the Examiner rejected on prior art whereas the Examiner never considered article of manufacture claims 28-51 in that application. With the present reissue claims drawn to a composition, and article of manufacture and a film, the prosecution of the grandparent application does not bear on any recapture issues in the present application.

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Applicants rely on the arguments in their January 26, 2001 Response regarding the inapplicability of the prosecution of the parent application to the claims presented in this reissue application. Briefly, reissue claims 28, 29, 31 and 32, 58, 59, 65 and 66 contain the same silicon oxide precursor limitations as claims 1-27 of the parent application and the limitation of coating speeds of greater than 350 Å/sec. They do not recapture any matter given up in the prosecution of the parent application by claiming metal oxides in lieu of the tin oxide and a broader class of accelerants.

The prosecution of the parent application shows that the Examiner considered the silicon oxide precursor as the only element requiring amendment and did not in any way suggest or require amendment of the tin oxide or the accelerant. Applicants responded to this rejection by amending the silicon oxide precursor limitation, and also broadened the definition of the accelerants in the parent application, however, the Examiner did not object to this broadening, further indicating that the original rejection focused only on the silicon oxide precursor.

The balance of the reissue article and film claims 33-57 and 60, without specifically mentioning the deposition rate, or the silicon oxide precursor broadly include both, which the great-grandparent and grandparent applications support. Applicants, however, never presented these claims in the parent application, so the rejections in that application don't apply to them.

Further with regard to reissue article and film claims 33-57 and 60, applicants did not amend the supporting claims in the great-grandparent and grandparent applications, did not present arguments relative to the scope of these claims in those applications that responded to any prior art or other rejections, nor did the Examiner ever indicate

they were allowable because of certain claim elements. Applicants did not acquiesce to any restrictions and rejections in the great-grandparent and grandparent applications, which were not final rejections. These restrictions and rejections subsequently became moot when applicants filed their CIP application.

Similarly, applicants never presented reissue claims 33-38, 50-52 or 56-60 which claim a film in either the great grandparent, grandparent or parent applications and the recapture doctrine cannot apply to them.

### Conclusions

The non-priority PCT applications do not bear on the prosecution of the present application since applicants have not identified them for priority purposes, and have not given up subject matter in those applications that led to the allowance of the parent application. Rule 14 preserves those applications in confidence and accordingly, applicants have not specifically discussed the contents of those applications or their serial numbers or filing dates. The foregoing reasons also demonstrate why the prosecution of the article of manufacture claims of the great grandparent application, the method claims of the grandparent application, and the composition claims of the parent application do not apply to any recapture issues in the present reissue application.

For all the foregoing reasons and remarks, Applicants respectfully request that the Examiner withdraw the rejection and allow all of the reissue claims so that the Patent and Trademark Office can declare an interference with at least Athey et al., United States Patent No. 5,536,718, and/or other related patents.

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If filing this amendment requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension fee or other fee which this amendment fails to account for, Applicants' attorneys request such an extension and payment of any fees due from their Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 9, 2001

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

David A RUSSO et al.

Serial No.: 08/544,212

Filed: October 17, 1995

For: COATING COMPOSITION FOR  
GLASS

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) Group Art Unit: 1755  
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) Examiner: D. Brunsman  
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Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**37 C.F.R. § 1.121 (c) (ii) Submission of Marked Up Version of Amended Claims**

Applicants submit the following marked up version of amended claims as required by 37 C.F.R. § 1.121 (c) (ii) to accompany the amendment filed with this submission.

**AMENDED CLAIMS:**

34. (Amended Twice) The film of claim 33 wherein the [organic] phosphite accelerants have the formula  $(R''O)_3P$  where  $R''$  is independently chosen from straight, cyclic or branched-chain alkyl or alkenyl of from one to about six carbons' phenyl, substituted phenyl, or  $R'''CH_2CH_2-$ , where  $R'''$  is  $MeO_2C-$ ,  $EtO_2C-$ ,  $CH_3CO-$ , or  $HOOC-$ .

35. (Amended Twice) The film of claim 33 wherein the [organic]borate accelerants have the formula  $(R''O)_3B$  where  $R''$  is independently chosen from straight, cyclic or branched-chain alkyl or alkenyl of from one to about six carbons' phenyl, substituted phenyl, or  $R'''CH_2CH_2-$ , where  $R'''$  is  $MeO_2C-$ ,  $EtO_2C-$ ,  $CH_3CO-$ , or  $HOOC-$ .


### REMARKS

The amendments to claims 34 and 35 delete the term "organic" before "phosphite" and "borate" respectively since the formulas for these compounds inherently include the term in the radical "R." The amendment therefore does not go to issues of patentability.

If filing this response requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension fee or other fee which this response fails to account for, Applicants' attorneys request such an extension and payment of any fees due from their Deposit Account No. 06-0916.

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